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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 07/427,986 | 10/27/99 | SAKSUN J | SAK007/JTN |

JAMES T NENNIGER
PIASETZKI AND NENNIGER
120 ADELAIDE STREET WEST SUITE 2308
TORONTO, ONTARIO ON M5H 1T1
CANADA

IM52/0705

AIR MAIL

EXAMINER

LEE, E

ART UNIT PAPER NUMBER

1732

DATE MAILED: 07/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

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Office Action Summary

Application No.

09/427,986

Applicant(s)

SAKSUN, JOHN

Examiner

EDMUND H LEE

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 27-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

1. Claims 27-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 is indefinite because it appears to be missing a step. The claims abruptly ends with the word "and" (cl 27, ln 7).

Clarification and/or correction is required.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Florian (USPN 3843122). Florian teaches the claimed process including positioning weights within a mold (col 2, lns 29-51; fig 3)--as a note, the castings provide weight to the club; molding a main body around the weights including a shaft receiving bore in the main body (figs 2-4); forming a front insert receiving pocket on the main body (fig 3 and 5); inserting an insert into the insert receiving pocket (col 4, lns 5-25; fig 5); using mounting pins (fig 2-3); and molding the front insert pocket in a first molding step (figs 2-3).

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florian (USPN 3843122). The above teachings of Florian are incorporated hereinafter. Florian does not teach machining the pocket into the front face of the main body; molding the insert into the pocket; machining a desired loft and groove into the front face. In regard to machining the pocket into the front face of the main body, it is notoriously well-known in the golf club art that machining a pocket into the face of a club or molding the face to have the pocket are equivalent alternatives. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to machine the pocket of Florian instead of molding the pocket since they are well-known equivalent alternatives. In regard to molding the insert into the pocket, it is notoriously well-known in the golf club art to mold an insert into a pocket in the face of the club. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mold the insert into the pocket of Florian instead of using adhesives in order to better integrate the insert into the pocket of Florian. In regard to machining a desired loft and groove into the front face, such is notoriously well-known in the golf club art in order to produce a high quality golf club. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to finish the club of Florian in order to produce a high quality club.

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6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baker et al (USPN 3172667) teach cutting a head to produce a pocket, molding an insert into the pocket and then machining the face (figs 1-7). Burr (USPN 3218072) teach the equivalence of molding or machining a pocket into a head.

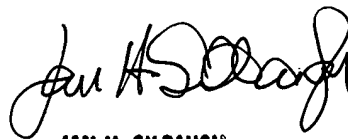
7. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Edmund Lee whose telephone number is (703)305-4019. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached on (703)308-3829. The fax phone number for this Group is (703)305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0661.

EHL

July 2, 2001


JAN H. SILBAUGH
SUPERVISORY PATENT EXAMINER
ART UNIT 1732

07/02/01